



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

16 MAR 2007

Jason A. Bernstein  
Powell Goldstein, LLP  
One Atlantic Center  
14<sup>th</sup> Floor  
1201 West Peachtree Street, NW  
Atlanta, GA 30309-3488

In re Application of :  
GEROLD :  
Application No.: 10/596,797 :  
PCT No.: PCT/EP04/10081 : DECISION ON PAPERS  
Int. Filing Date: 07 September 2004 :  
Priority Date: 24 December 2003 : UNDER 37 CFR 1.42  
Attorney Docket No.: ~~149549-00002~~ 149459.00002 :  
For: RADIO-OPAQUE MARKER FOR :  
MEDICAL IMPLANTS :

This application is before the Office of PCT Legal Administration for issues arising under 35 U.S.C. 371. The declaration filed 23 June 2006 is being treated as a request for status under 37 CFR 1.42. No petition fee is due.

**BACKGROUND**

On 07 September 2004, applicant filed international application PCT/EP04/10081 which claimed priority to an earlier application filed 24 December 2003. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 21 July 2005. Pursuant to 37 CFR 1.495, the deadline for payment of the full, U.S. basic national fee was set to expire on 24 June 2006.

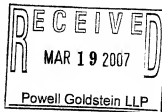
On 23 June 2006, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a First Preliminary amendment; substitute specification and executed declaration.

**DISCUSSION**

37 CFR 1.42 When the Inventor is Dead, states, in part:

"In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent."

The declaration submitted on 23 June 2005 was executed by Eva Heublein, Nora



Heublein and Christoph Heublein as legal representatives of the estate of deceased inventor, Bernd Heublein. However, the filed declaration does not satisfy the requirements under 37 CFR 1.497(b). Specifically, the oath or declaration must at a minimum provide the citizenship of the deceased inventor, as well as, state the relationship of the signing individual to the non-signing inventor. While the declaration does state that Eva Heublein, Nora Heublein and Christoph Heublein are the legal representatives to the estate of the deceased inventor, the declaration and provides only the residence, citizenship, and post office address for the legal representatives. Accordingly, the declaration is not in compliance with 37 CFR 1.497(a)(3). Applicant should also review 37 CFR 1.497(c) as an application data sheet has not been filed in the present application.

### **CONCLUSION**

Applicant's petition under 37 CFR 1.42 is **DISMISSED, without prejudice.**

Applicant is hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file an oath or declaration in compliance with 37 CFR 1.497 (a)-(b). Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.42." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3294  
Fax: (571) 273-0459